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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/571,249	03/09/2006	Toshio Shimizu	0408947417	6215

9629 7590 06/26/2007
MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

NASH, BRIAN D

ART UNIT	PAPER NUMBER
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3721

MAIL DATE	DELIVERY MODE
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06/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/571,249	Applicant(s) SHIMIZU ET AL.	
	Examiner Brian Nash	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Examiner's Comments

1. This action is in response to applicant's amendment received 3/26/2007. The pending claims remain 1-4.
2. The Examiner notes that while the amendments to claim two have remedied the issue of indefiniteness, the claim still fails to further limit the structure of the apparatus, but rather claims how certain elements of the apparatus move during the operation of the stapler's cutter unit. While it is permissible for features of an apparatus to recite either structurally or functionally, claims directed to an apparatus should distinguish from the prior art in terms of structure rather than function. Therefore, claim two is not considered to define any structural limitations over the prior art.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by the admitted prior art (APA), specifically JP-Y-03-025930 (hereinafter JP '930). JP '930 (see specs pgs 3-4) discloses the same stapler:

With respect to claim 1, JP '930 discloses a striking mechanism, a movable clincher for folding to bend staple legs penetrated through a bundle of sheets, a cutter unit comprising a fixed cutter and a movable cutter and wherein the cutter unit is arranged to move between two positions.

With respect to claim 2, as discussed above the claim is directed toward the operation of the cutter unit without further limiting the structure of cutter unit or the stapler apparatus. JP '930 discloses a cutter unit the functions with a moveable clincher mechanism and therefore anticipates the claim.

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With respect to claim 3, JP '930 shows an opening formed at the cutter unit and a chute arranged on a lower side thereof for the cut pieces of the leg portions of the staples (see Fig. 7).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art (APA), specifically JP-Y-03-025930 (hereinafter JP '930) in view of JP-Y-03-025931 (hereinafter JP '931). As discussed above, the APA discloses the invention substantially as claimed, but does not show a chute for discarding cut pieces of staples that have been cut by the cutter mechanism. JP '931 shows a chute pivotal chute having a first and second end portion arranged at an inclination for the purpose of discarding the cut pieces of the staple legs (see Figs. 1 and 2). It would have been obvious to one skilled in the art to configure/modify the chute mechanism design of JP '931 with the stapler apparatus of JP '930 for discarding the cut pieces, since such a modification is within the engineering purview of the skilled artisan concerned with removing the cut pieces of the bent staple leg portions so that they do not interfere with the operation of the stapler.

Response to Arguments

7. *In re* claim 1, applicant's arguments filed 3/26/2007 have been fully considered but they are not persuasive. Applicant contends, *inter alia*, that JP '930 does not perform the same function as the claimed invention. Specifically, applicant contends that JP '930 does not disclose a fixed and movable cutter unit. Examiner acknowledges applicant's position; however, a reference is deemed to properly anticipate a claim when all the recited limitations are disclosed therein. In this instance, JP '930 (as discussed in the office action above) clearly shows all the recited structural limitations including a cutter

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unit comprising both a movable cutter and a fixed cutter. While it is noted that the device of JP '930 may not perform the same function or in the same manner as applicant's invention, it is deemed that the claims are not restrictive to such device.

For the reasons above, the grounds for rejection are deemed proper.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Nash whose telephone number is 571-272-4465. The examiner can normally be reached on Monday – Thursday from 8 a.m. to 6 p.m.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached at 571-272-4467. The official fax number for this Group is: 571-273-8300

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

6/23/2007


BRIAN D. NASH
PRIMARY EXAMINER
TECHNOLOGY CENTER 3700